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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



035811

PATENT & TRADEMARK OFFICE

In re reissue application of:
Patent No. : 5,948,525
Issued : September 7, 1999
Inventors : Masahiro Kimura
: Kohzo Takahashi
: Hiroji Kojima
: Koichi Abe
Title : BIAXIALY STRETCHED
: POLYESTER FILM FOR
: FORMING CONTAINER
: AND METHOD OF
: PRODUCING THE FILM

RECEIVED
JUL 30 2003
TC 1700

Docket No.: 1001-RE-98

Confirmation No.: 1861

Dated: June 25, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Certificate of Mailing Under 37 CFR 1.8

For

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Claim of Extension of Response, in duplicate
Response
Original U.S. Patent 5,948,525
Original Certificate of Correction
Oath/Declaration

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date appearing below.

Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

Piper Rudnick LLP
Customer No. 35811

By: TR

Date: 25 JUN 2003



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RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is submitted in response to the Official Action dated February 11, 2003.

The Applicants acknowledge that the original Patent or a statement as to loss or inaccessibility must be received before the Application can be allowed. The original Patent and the original Certificate of Correction are enclosed herewith.

The Applicants also submit a new Oath/Declaration identifying the specific errors, namely the errors in claim dependencies, and, as a consequence, that the Applicants claimed less than they had a right to claim in the original Patent. The Applicants note for the record that, under the updated Rules, the reasons for occurrence of the error, other than a statement of the fact that the error was without any deceptive intention, is no longer necessary. In that regard, we invite the Examiner's attention to new §175 of 37 C.F.R.

With respect to the changes made by the Certificate of Corrections, the Applicants enclose copies thereof in accordance with §173(a)(1).

Turning now to the merits, the Applicants respectfully submit that all of the solicited claims are patentable over JP '757 for the reasons set forth in detail below.

JP '757 discloses a polyester resin composition having excellent transparency and heat resistance. This is useful for a stretched bottle. The reason for such transparency of the polyester resin is to prepare a plastic bottle as a substitute for a glass bottle. Accordingly, it is apparent that JP '757 does not have the slightest idea how to laminate the polyester resin on a metallic sheet as is conducted in the invention. Although JP '757 discloses how to prepare a polyester film, it also discloses that both unstretched and stretched films are useful.

On the other hand, the polyester film of this invention is biaxially stretched to improve heat resistance and taste property (see Column 3, lines 53 – 55 in the issued Patent). The refractive index in the direction of thickness of the film is 1.5 or more in view of drawing formability and laminate characteristics (see Column 3, lines 20 – 22). These claimed features are not taught or suggested in JP '757.

With regard to the importance of the refractive index of 1.5, we invite the Examiner's attention to Example 5 and Comparative Example 2 of the Applicants' Specification. The refractive index of Example 5 is 1.525 (see Table 2). The refractive index of Comparative Example 2 is 1.497 (see Table 6-continued). Comparing the resultant film properties, i.e., formability, scrape resistance, impact resistance and taste property, it is quite clear that the film of Example 5 is far superior to the film of Comparative Example 2. Thus, the refractive index is important and anything but obvious over JP '757.

The Applicants respectfully submit that not only is the invention as recited in the solicited claims not obvious over JP '757, but JP '757 is actually non-enabling as prior art. The disclosure

that is relied upon in the rejection is limited to the following:

PURPOSE: To prepare a polyester resin compsn. useful for producing a stretched bottle excellent in the transparency, heat resistance, and gas barrier properties by compounding polyethylene terephthalate, polyethylene naphthalate, and a premixture of polyethylene terephthalate with polyethylene naphthalate, each in a specified amt.

CONSTITUTION: 100 pts.wt. in total of 10 to 90 pts.wt. polyethylene terephthalate and 90 to 10 pts.wt. polyethylene naphthalate is compounded with 1 to 20 pts.wt. premixture of 20 to 80wt.% polyethylene terephthalate with 80 to 20wt.% polyethylene naphthalate.

There is not one word concerning biaxial stretching, which is an explicitly claimed portion of this invention. The Applicants' film is a biaxially stretched polyester film. There is not one word in JP '757 concerning biaxial stretching. As a consequence, there is inherently nothing in JP '757 that provides one of ordinary skill in the art as to reasons why biaxial stretching could be performed and what advantages, if any, would result as a consequence of such biaxial stretching.

Also, there is not one word considering the refractive index as recited in the claims. Other than a passing reference to excellence in transparency, there is utterly no disclosure on this point at all. As a consequence, one of ordinary skill in the art would have nothing to work from when viewing JP '757. Withdrawal of the 35 U.S.C. §103 rejection is accordingly respectfully requested.

In light of the foregoing, we respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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